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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/689,343	10/20/2003	Katsumi Ochiai	FS.20124US0A	2902
20995	7590	08/17/2004	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP			OLSON, LARS A	
2040 MAIN STREET			ART UNIT	PAPER NUMBER
FOURTEENTH FLOOR				
IRVINE, CA 92614			3617	

DATE MAILED: 08/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/689,343	OCHIAI ET AL.
	Examiner Lars A Olson	Art Unit 3617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-28 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 1-21 and 25 is/are allowed.
- 6) Claim(s) 22-24 and 26-28 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 2/17/2004 is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 10202003.

- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 22 objected to because of the following informalities: Claim 22 is in dependent form, depending from claim 22, thus depending from itself. Appropriate correction is required.
2. Claim 28 objected to because of the following informalities: Claim 28 is in dependent form, depending from Claim 29, which does not exist. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 22-24 and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. Claim 22 recites the limitation "The marine drive" in line 1. There is insufficient antecedent basis for this limitation in the claim.
6. Claim 28 recites the limitation "The watercraft" in line 1. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 26-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Okita (US 5,408,230).

Okita discloses the same watercraft as claimed, as shown in Figures 1-4, that is comprised of a marine drive, defined as Part #12, a shift operating device, defined as Part #15, with a control member, defined as Part #16, and a control device, defined as Part #47, where said marine drive is further comprised of a propulsion device, a transmission that is coupled with said propulsion device, and a shift mechanism, as shown in Figure 1, that is arranged to move said transmission between a first position and a second position, said shift mechanism being further comprised of a shift unit or transmission control lever, and an electrically operated shift actuator, defined as Part #18, with an actuating member, defined as Part #17, that is coupled with said shift unit, as described in lines 46-54 of column 2, and where said shift operating device provides a shift position command to said control device, as described in lines 48-59 of column 3, and said control device controls said shift actuator to move said actuating member based upon said shift position command as detected by a control position sensor, defined as Part #43, that is arranged to sense a forward, neutral or reverse control position of said control member, as shown in Figure 1.

***Allowable Subject Matter***

9. Claims 1-21 and 25 are allowed.
10. Claims 22-24 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Sawyer (US 6,692,320) discloses a gear selector actuation system for a marine propulsion device. Kolb et al. (US 6,485,340) discloses an electrically controlled shift system for a watercraft. Takase (US 6,238,255) discloses a shift mechanism for a marine propulsion system that includes a guide member for a shift unit that is moved by a shift actuator. Nagafusa (US 5,318,466) discloses an electrically driven actuator for controlling a throttle cable and a shift cable of a marine propulsion system. Schmidt et al. (US 5,242,320) discloses a single lever shift control system for a watercraft that includes a shift actuator in the form of a solenoid.
12. Any inquiry concerning this communication from the examiner should be directed to Exr. Lars Olson whose telephone number is (703) 308-9807.

lo

August 12, 2004

LARS A. OLSON  
PATENT EXAMINER

*Lars Olson*  
8/12/04